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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,754	05/01/2001	Albert A. Reff	43569.010400	3682
23363	7590	08/24/2006	EXAMINER	
CHRISTIE, PARKER & HALE, LLP PO BOX 7068 PASADENA, CA 91109-7068			THEIN, MARIA TERESA T	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,754

Applicant(s)

REFF, ALBERT A.

Examiner

Marissa Thein

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on June 5, 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The "Amendment" filed on June 5, 2006 has been considered.

The Examiner notes that applicant must make an affirmation of the election.

During a telephone conversation on February 15, 2006 with Mr. Kimbell, a provisional election was made without traverse to prosecute the invention of I, claims 1-5 and 7-10.

Claim 1 is amended. Claims 1-5 and 7-10 remain pending in this application. Claims 17-20 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S.

Patent No. 4,943,939 to Hoover.

Hoover discloses the scanner (col. 4, lines 3-6); a container (col. 2, lines 56-61; col. 5, lines 28-52); counter (col. 2, lines 40-44); and a reconciling device (col. 2, line 62 – col.3, line 6; col. 3, line 64 – col. 4, line 6). The Hoover reference is capable of performing the recited functions.

Examiner notes that the clauses "for..." and "adapted for..." are statements of intended use, which do not patentably, distinguish the claimed apparatus.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,943,939 to Hoover in view of U.S. Patent No. 5,629,498 to Pollock et al.

Hoover, substantially discloses the claimed invention, however, it does not disclose a reader [**claim 2**]; an identification device [**claim 3**]; a memory [**claims 4-5**]; an internal counter which is connected the counter [**claims 7-8**]; an alarm mechanism [**claim 9**]; disposable jar and a light emitting diode display [**claim 10**]. Hoover discloses a digital computer for receiving and decoding signals from the dispenser and the storer which decoded signals to enable the computer to count the number of surgical instruments dispensed and received (col. 2, lines 38-44). Hoover further discloses a computer scanning a digital image or dark and light areas created by the instruments (col. 4, lines 3-5).

Pollock, on the other hand, teaches a scanner includes a reader (col. 8, lines 33-39); an identification device (col. 8, lines 31-60); a memory (col. 9, line 42); an internal counter which is connected the counter (col. 6, line 63 – col. 7, line 7; col. 7, lines 64-67;

col. 9, lines 1-12); an alarm mechanism (col. 3, lines 39-41); disposable jar and a light emitting diode display (col. 3, lines 3-7; col. 10, lines 2-4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the apparatus of Hoover, to include a reader, an identification device, a memory, an internal counter, an alarm mechanism, a disposable jar and light emitting diode, as taught by Pollock, in order to decrease the potential for errors in the counting and tracking process (Pollock, col. 2, lines 32-33).

Response to Arguments

Applicant's arguments filed June 5, 2006 have been fully considered but they are not persuasive.

Applicant remarks that Hoover does not teach "a container". Applicant further remarks that "the container identified by the Examiner is actually a modified Mayo stand".

The Examiner notes that Hoover does teach "a container". Hoover teaches an apparatus for accounting for surgical instrument dispensed into and withdrawn from the surgical operating environment (abstract). In col. 5, lines 37-44, Hoover further teaches a storer of used instruments and a digital computer for receiving and decoding signals from the dispenser and the storer which decode signals to enable the computer to count the numbers of surgical instrument dispensed and received and to compare the number of instruments entering the operating environment from the dispenser to the number removed to the storer from the operating environment. The storer is a modified Mayo stand (col. 2, line 55). The modified Mayo stand has a transparent surface supported

by a pedestal. The surface has edges raised for elevating instruments placed thereon between uses and after use. (Col. 5, lines 28-32) An array of fiber optic filaments is in the surface of the Mayo stand (col. 5, lines 34-35).

Such storer of used instruments and a digital computer for receiving and decoding signals from the dispenser and the storer which decode signals to enable the computer to count the numbers of surgical instrument dispensed and received and to compare the number of instruments entering the operating environment from the dispenser to the number removed to the storer from the operating environment; the storer being a modified Mayo stand with a transparent surface wherein the surface has edges raised and an array of fiber optic filament are considered the container.

Applicant remarks "that Hoover does not actually disclose a container for receiving the medical objects, so that the Examiner would need to relay on Pollock for this element". Furthermore, Applicant remarks "that it is therefore clear that one having ordinary skill in the art would have no motivation to combine the two references...".

The Examiner notes that Hoover does disclose the container, as discussed above. Pollock was cited for teaching the scanner, an identification device, a memory, an internal counter; an alarm mechanism; and a disposable jar and a light emitting diode display used in a tracking device in a surgical environment.

In response to applicant's remark that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation was “to decrease the potential for errs in the counting and tracking process” found in Pollock, col. 2, lines 32-33.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mtot
August 18, 2006

Elvin Dd 8/18/06
Primary Examiner